

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

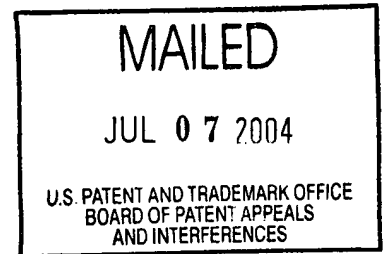
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JAY PAUL DRUMMOND, DALE BLACKSON,  
BOB A. CICHON, JOSEPH C. ESS,  
MARK S. COVERT, MARK A. MOALES,  
DAVID W. WEIS, MARK D. SMITH,  
BRUCE G. RICHARDS and JAMES CHURCH

Appeal No. 2003-0980  
Application No. 09/193,646

ON BRIEF



Before THOMAS, JERRY SMITH, and LEVY, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-33, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to an automated banking system. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced as follows:

1. Apparatus comprising:

an automated transaction machine including:

a computer, the computer in operative connection with a memory;

an input device in operative connection with the computer, wherein the input device is operative to accept user inputs;

a sheet dispenser in operative connection with the computer, wherein the sheet dispenser is operative to dispense sheets;

software executable in the computer, wherein the software includes a first object operative to control the input device, and a second object which is operative to control the sheet dispenser, wherein the computer is operative to access at least one HTTP address, wherein transaction device instructions are accessible at the address, and wherein the first object operates the input device and the second object operates the sheet dispenser responsive to the instructions, and wherein the software further includes a transaction data object, wherein the transaction data object is in operative connection with the first object and second object and is operative to store therein data representative of both user inputs to the input device and the dispense of sheets by the dispenser.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wynn	5,859,419	Jan. 12, 1999 (filed: Sep. 28, 1999)
Zeanah et al. (Zeanah)	5,933,816	Aug. 3, 1999 (filed: Aug. 7, 1997)

Claims 1-22 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zeanah.

Claims 23-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zeanah in view of Wynn.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 18, mailed October 22, 2002) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 17, filed August 2, 2002) and reply brief (Paper No. 20, filed January 23, 2003) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR 1.192(a).

#### OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision,

appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse and remand the application to the examiner for further consideration of the issues raised, infra. We begin with the rejection of claims 1-22 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Zeanah. Appellants assert, at the outset (brief, page 8) that "[t]he present invention claims the benefit of the November 27, 1996 filing date of provisional application 60/031,956," and that Zeanah's provisional application does not comply with the first paragraph of 35 U.S.C. § 112. It is asserted (brief, page 9) that Zeanah is only entitled to the non-provisional application filing date of August 7, 1997, which is subsequent to the filing date of appellants' provisional application, filed November 27, 1996.

It is argued (brief, pages 8 and 9) that Zeanah's provisional application does not contain sufficient information to enable one skilled in the art to make and use an operable system without undue experimentation. Appellants list (brief, pages 9 and 10) the "Wands Factors" for determining whether undue experimentation would be required to make and use the invention,

and assert (brief, page 10) that "[b]ased on the evidence regarding each of the above factors, Zeanah's provisional application would not have taught one skilled in the art, at the date of filing, how to make and use the full scope of any invention without undue experimentation." Specifically, it is argued (id.) that the provisional application comprises three documents: a first document (pages 1-9); a second document, (pages i to A-5); and a third document (section numbered pages 1-47).

Appellants argue that the first document is a requirements document of what the inventors would like to do, but lacks any presentation of knowledge of how to do it, and that the document merely provides proposed documents for an alleged conceptual system. Appellants note (id.) that the first document uses phrases such as "A user should be" or "there should be a mechanism" or "The architecture should support," and does not use phrases such as "a user is able."

With respect to the second document of Zeanah's provisional application, appellants assert (brief, page 11) that "[t]he primary focus of this document is the conceptual application architecture' and that 'following the adaption of this conceptual architecture, the next level of design work will take place

fleshing out the details.' Section A.7 (pages A-4 and A-5) begins the 'hypothetical examples that must assume some implementation details which will change when the detailed application framework design is done." According to appellants (id.), "the provisional application reveals that after the alleged concept was completed (which it was not), then the next work (which hadn't even started yet) would involve figuring out the details (the guts of any inventive subject matter) necessary in order to implement the asserted concept." It is argued (id.) that "[c]learly one skilled in the art would not have been able to make and use the deficient incomplete concept (i.e., the alleged 'invention') disclosed in the Zeanah provisional application without undue experimentation. Thus, the second document does not provide an enabling system."

Turning to the third document of the provisional application of Zeanah, appellants assert (brief, pages 11 and 12) that "[t]he third document comprises presentation overheads which again are evidence that the disclosure was merely a theoretical idea without any enablement or reduction to practice." It is argued that page 2 of the third document lists the five process steps needed to reduce to practice the asserted conceptual idea, and

that review of the provisional document reveals that only one step (basic theoretical idea) was ever begun. Appellants argue that page 47 of the document makes clear that steps 2-4 were yet to begin, and that the next steps of obtaining an architecture, selecting the proper tools, defining an implementation strategy, staffing a design team, and starting the detailed design were not yet completed. From all of the above, appellants conclude that the provisional application of Zeanah does not meet the requirements of 35 U.S.C. § 112, first paragraph, and that Zeanah is, at best, only entitled to the August 7, 1997 filing date of the non-provisional application.

In response, the examiner takes the position (answer, pages 6 and 7) that appellants' position is based solely on Zeanah's use of conditional words, such as "should" or "will." It is argued that "by reading the application, beyond the requirements section, one of ordinary skill would find ample support for features described in the '816 Patent such as Mini-App, NetCAT, Dialog, Business, Session, Transaction, Touch Point, Customer, System and Peripheral Services, Legacy Migration, Rule Broker, and Tools and Languages (Zeanah et al. Provisional Application, see for example Table of Contents; '816, column/line 6/11-30/15). Hence, the written description and drawings of the provisional

application adequately support and enable the subject matter claimed in the non-provisional application and therefore the '816 patent claim to the October 31<sup>st</sup>, 1996 date is valid "

From our review of the record, we agree with the examiner that appellants' position is based upon the use of conditional words in the Zeanah provisional application, and note that appellants do not specifically address the merits of whether the language of the provisional application of Zeanah provides support for the claims of the Zeanah patent. Although appellants list the "Wands Factors" appellants do not specifically discuss them, nor point out any of the factors that they consider to not apply to the issue of enablement in the issues on appeal. However, we also find that the examiner's broad reference to essentially the entire detailed description of Zeanah (col. 6, line 11 through col. 30, line 15), and the examiner's broad reference to the fact that the provisional application provides a discussion of the system architecture with respect to system components, is not sufficient to establish that the portions of the Zeanah patent relied upon by the examiner in making the rejection, have support in the provisional application of Zeanah. The initial burden of proof rests with the examiner. In view of appellants challenge to the examiner's reliance on the filing



date of the provisional application of Zeanah, it is incumbent upon the examiner to establish the effective date of the reference relied upon in rejecting appellants' claims. The sweeping statements of the examiner (answer, pages 6 and 7) are insufficient to establish that the provisional application of Zeanah provides support for the portions of the Zeanah reference relied upon by the examiner in the rejection. The review authorized by 35 U.S.C. Section 134 is not a process whereby the examiner . . . invite[s] the [B]oard to examine the application and resolve patentability in the first instance." Ex parte Braeken, 54 USPQ2d 1110, 1112 (Bd.Pat.App. & Int. 1999). In an *ex parte* appeal, "the Board is basically a board of review - we review . . . rejections made by patent examiners." Ex parte Gambogi, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). Here, because the examiner's actions are incomplete, "[t]he appeal is manifestly not ready for a decision on the merits." Braeken, 54 USPQ2d at 1112.

Accordingly, we find that the examiner has failed to establish a prima facie case for the filing date relied upon in the rejection of claims 1-22 and 33 under 35 U.S.C. § 103(a). As the examiner has failed to establish an effective date of the

reference that is prior to appellants asserted<sup>1</sup> effective filing date of appellants' provisional application, the rejection of claims 1-22 and 33 under 35 U.S.C. § 103(a) is reversed.

We turn next to the rejection of claims 23-32 under 35 U.S.C. § 103(a) as being unpatentable over Zeanah in view of Wynn. We cannot sustain the rejection of claims 23-32 because there is no evidence in the record that would establish that Wynn makes up for the deficiencies of Zeanah. Accordingly, the rejection of claims 23-32 under 35 U.S.C. § 103(a) is reversed.

REMAND TO THE EXAMINER

Base on our findings, supra, we remand the case to the examiner for consideration of the issues which follow.

Appellants assert (brief, page 8) that appellants claim the benefit of the November 27, 1996 filing date of provisional application 60/031,956.

We observe that the application is a Continuation-In-Part of a PCT application PCT/US97/21422 filed November 27, 1997, which claims priority, inter alia, from provisional application 60/031,956 filed November 27, 1996. Because the application is a

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<sup>1</sup> We further address the issue of whether appellants are entitled to the filing date of their provisional application 60/031,956, filed November 27, 1996 in the Remand, found infra.

CIP of a PCT application, and appellants have claimed the benefit of the filing date of provisional application 60/031,956, the examiner needs to review the provisional application relied upon by appellants, as well as the PCT application and make a determination of whether appellants have support in the prior applications for the subject matter claimed in the appealed application. If the examiner determines that appellants are in fact entitled to the benefit of the filing date of provisional application 60/031,956 then the examiner should additionally make a determination of whether there is support in the provisional application of Zeanah for the portions of Zeanah relied upon by the examiner in the rejections of the claims over Zeanah alone or in combination with Wynn. In doing so, it is not sufficient to make broad reference to the provisional application or its disclosure of system components. The examiner needs to find specific support for the portions of Zeanah relied upon on pages 3-5 of the examiner's answer. From our review of the provisional application of Zeanah, we direct the examiner's attention to pages 2-3 through 2-11 of the second Zeanah document and to slides 37-44 of the third Zeanah document, in addition to the remainder of the provisional application.

In addition, assuming that the examiner is able to establish a prima facie case that the portions of Zeanah relied upon have support on Zeanah's provisional application, the examiner needs to address each of the claims separately argued by appellants. We observe that appellants separately argue each of the claims on appeal (see for example pages 18-35 of the brief), whereas the examiner has only presented one set of arguments for the claims rejected over Zeanah, and has provided one set of arguments for the claims rejected over the teachings of Zeanah and Wynn. In responding to appellants arguments, it is necessary for the examiner to specifically respond to each claim separately argued.

In summary, the application is remanded to the examiner to:

- (a) make a determination of whether this CIP of PCT/US97/21422 is entitled to the filing date of provisional application 60/031,956 filed November 27, 1996;
- (b) if appellants are in fact entitled to the filing date of provisional application 60/031,956 filed November 27, 1996, the examiner should make a determination of whether the provisional application of Zeanah provides support the portions of Zeanah relied upon by the examiner in the rejection, and
- (c) if there is support in the provisional application of Zeanah for the portions of the reference relied upon in the

rejection, the examiner should repeat the rejection and additionally address the arguments presented for each claim separately argued by appellants.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1-33 under 35 U.S.C. § 103(a) is reversed. In addition, we remand the application to the examiner for consideration of the issues presented, supra.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01. It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this application.

If after action by the examiner in response to this remand there still remains decision(s) of the examiner being appealed, the application should be promptly returned to the Board of Patent Appeals and Interferences.

We hereby remand this application to the examiner for action as required by this remand, and for such further action as may be appropriate.

JAMES D. THOMAS  
Administrative Patent Judge

*Jerry Smith*  
JERRY SMITH  
Administrative Patent Judge

BOARD OF PATENT  
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INTERFERENCES

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